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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,883	04/12/2004	Russell A. Firestone III	36707-501	2490

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EXAMINER	
CONLEY, SEAN EVERETT	
ART UNIT	**PAPER NUMBER**
1797	
MAIL DATE	**DELIVERY MODE**
12/17/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/821,883	FIRESTONE ET AL.	
	Examiner	Art Unit	
	SEAN E. CONLEY	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 October 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) *23-25* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/30/04, 3/23/06, 1/9/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of group I, claims 1-22 in the reply filed on October 22, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 23-25 are withdrawn from consideration for being directed to a non-elected invention.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-17, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldner et al. (U.S. Patent No. 5,270,000) in view of Nealy-Brown (article titled “Paper Shredding Business Piles Up").

Goldner et al. discloses an apparatus and process for treating medical wastes (2) such as bandages, syringes, and wastes produced daily from hospitals (see col. 1, lines 5-16). The process comprises the step of first shredding the waste (2) in loading chamber (3) using a refuse comminutor (7) (see col. 4, lines 18-39). The loading chamber (3) is heated with conductive heat from a heating circuit so that the wastes may be preheated (see col. 10, lines 18-38). After the wastes are ground up they are sent to the treatment section which comprises a microwave chamber (16) and a temperature maintenance chamber (17). Prior to entering the microwave chamber the waste is sprayed with water in transfer tunnel (18) to moisten the waste prior to microwave treatment (see col. 4, lines 40-53). The moistened waste is then treated with microwaves in the microwave chamber (16) to heat the waste (see col. 5, lines 7-38). After heating by microwaves the waste is transferred to the temperature maintenance

chamber where it is held for a predetermined period of time and at a minimum temperature sufficient to ensure complete disinfection (see col. 6, line 47 to col. 7, line 6; see col. 8, lines 32-49). The process results in medical waste that has been shredded and disinfected with all pathogenic germs eliminated.

Goldner et al. fails to explicitly identify medical records as an item of medical waste that is treated in the process.

Nealy-Brown discloses in the article that shredding documents protects people's privacy. Types of documents that are shredded include documents with social security numbers, Medicaid numbers, employee information, and medical records. Furthermore, government regulations have helped the document destruction industry by requiring hospitals, doctors, pharmacies, and insurance companies to protect patient's medical records (by destroying them via shredding). (See entire article). It is well known that medical records include patient personal information such as protected health information, demographic information, addresses, dates of treatment, etc.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Goldner et al. to include the shredding of medical records in combination with the process of shredding medical wastes in the device disclosed by Goldner et al. since Nealy-Brown discloses that it is well known to shred medical records to protect patient privacy. Furthermore, it would have been obvious to combine the process of shredding medical records with the process of shredding medical waste since such a combination would yield the

predictable result of a more efficient removal of waste and documents from a hospital or doctors office using a single machine and a single process.

4. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldner et al. in view of Nealy-Brown as applied to claim 15 above, and further in view of Dineley et al. (U.S. Patent No. 5,209,411).

The combination of Goldner et al. and Nealy-Brown is set forth above. However, the combination of Goldner et al. and Nealy-Brown does not teach the step of subjecting the waste or documents to X-rays or ultraviolet light.

Dineley et al. disclose a process of shredding medical waste disposed from hospitals and other medical treatment facilities. The process comprises first comminuting the medical waste and then transferring the waste to a decontamination chamber where the waste is exposed to ultraviolet radiation alone or in combination with other treatments (see col. 1, lines 10-23; see col. 2, lines 1-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Goldner et al. to include an additional step of exposing the medical waste and documents to ultraviolet radiation as exemplified by Dineley et al. to yield the predictable result of further enhancing the overall disinfection and decontamination of the medical waste and documents by following one treatment (microwave exposure) with another (ultraviolet radiation) which produces a synergistic disinfection.

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldner et al. in view of Nealy-Brown as applied to claim 15 above, and further in view of Mosenson et al. (U.S. Patent No. 6,494,391 B2).

The combination of Goldner et al. and Nealy-Brown is set forth above. However, the combination of Goldner et al. and Nealy-Brown does not teach the step of subjecting the waste or documents to ozone.

Mosenson et al. teaches an apparatus and process for treating medical wastes. The process includes first shredding the medical waste and then exposing the shredded waste to gaseous ozone in order to disinfect the waste (see col. 1, lines 45-67; see col. 4,lines 21-30; see col. 5, line 49 to col. 6,line 35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Goldner et al. to include an additional step of exposing the medical waste and documents to gaseous ozone as exemplified by Mosenson et al. to yield the predictable result of further enhancing the overall disinfection and decontamination of the medical waste and documents by following one treatment (microwave exposure) with another (gaseous ozone) which produces a synergistic disinfection of the wastes.

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldner et al. in view of Nealy-Brown as applied to claim 1 above, and further in view of Orlando (U.S. Patent No. 5,186,397).

The combination of Goldner et al. and Nealy-Brown is set forth above. However, the combination of Goldner et al. and Nealy-Brown does not teach the step of compacting the shredded waste and documents after treatment.

Orlando discloses a method and device for disposal of medical waste. The process comprises shredding the medical waste after it has been sterilized in an autoclave. The process includes the additional step of compacting the medical waste in using piston (21) located below the shredding apparatus (13). The compact medical waste is held in storage area (2) where it is further compacted prior to eventual disposal (see figure 1; see col. 5, lines 22- 41; see abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process and invention of Goldner et al. and include a storage area with a means for and process step for compacting the shredded waste and documents after treatment as exemplified by Orlando in order to enable the mobile device of Goldner et al. to process additional amounts of medical waste with fewer trips to a landfill or dump site.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean E. Conley whose telephone number is 571-272-8414. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 12, 2008

/Sean E Conley/
Primary Examiner, Art Unit 1797